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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/787,037	02/24/2004	Akira Sugiyama	60896 (70551)	3898
21874	7590	09/22/2006	EXAMINER	
EDWARDS & ANGELL, LLP			MOORE, KARLA A	
P.O. BOX 55874			ART UNIT	
BOSTON, MA 02205			PAPER NUMBER	

1763

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/787,037

Applicant(s)

SUGIYAMA, AKIRA

Examiner

Karla Moore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP Patent Publication No. 2002-151494A to Yara et al. in view of 5,549,780 to Koinuma et al. and Japanese Patent No. 09092493 to Kubota et al.

4. Yara et al. disclose a plasma processing apparatus generating plasma under atmospheric pressure for processing object substantially as claimed and comprising: first (Figure 3, 3) and second (Figure 3, 2) electrodes adjacent to each other facing a surface of the object to be processed; a dielectric (4) having a first opposed surface positioned spaced apart from the surface of the object between the object and said first electrode and a second opposing surface positioned between the object and said second electrode, filled between said first and second electrodes and covering said coated surfaces; gas supplying means (7) having a supply opening (5) formed in said first opposing surface for supplying process gas to the surface of the object through said supply opening; and a gas exhausting means (10)

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formed on said second opposing surface for exhausting process gas to the surface of the object through said exhaust opening.

5. However, Yara et al. fail to disclose the electrodes having coated surfaces.

6. Koinuma et al. disclose coating the surface of electrodes for the purpose of protecting the electrode from processing gases (column 7, rows 25-33).

7. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to have provided coated electrodes in Yara et al. in order to protect the electrodes from processing gases.

8. Yara et al. and Koinuma et al. disclose the invention substantially as claimed and as described above.

9. However, Yara et al. fail to teach the gas exhausting means formed in a surface of the dielectric.

10. Kubota et al. teach forming a gas exhausting means in the surface of a dielectric (26-29) for the purpose of forming a surface treatment device capable of keeping treatment rates high and with simplified structure (abstract).

11. It would have been obvious to one of ordinary skill in the art to have also formed the gas exhausting means in the dielectric surface in Yara et al. and Koinuma et al. in order to for a surface treatment device capable of keeping treatment rates high and with a simplified structure as taught by Kubota et al.

12. With respect to claim 2, said gas supplying means is provided inside said first electrode, and said gas exhausting means is provide inside said second electrode.

13. With respect to claim 3, around said gas supplying means, an inner wall formed of a dielectric is formed (see Figure 3). With respect the gas exhausting means, Yara et al. do not explicitly teach forming a dielectric at this location. However, the disclosure is clear that forming the dielectric permits a normal plasma process method to be performed. One of ordinary skill in the art would recognize that the dielectric could be formed at other locations to further enhance the benefits provided by the dielectric.

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The courts have ruled that The mere duplication of parts has no patentable significance unless a new and unexpected result is produced. In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

14. With respect to claim 4, the coated surfaces of said first and second electrodes, respectively extend on a plane parallel to the surface of the object (the surface facing the object).

15. With respect to claim 5, in Yara et al., all of the electrodes are positioned on a single side of the substrate thus an electric line of force connecting said first and second electrodes when a voltage is applied between the electrodes extends above and substantially parallel to the surface of the object (in order that the object will be treated).

16. With respect to claim 6, said supply opening and said exhaust opening are provide in a vicinity of a region positioned between said first opposing surface and said second opposing surface (see Figure 3).

17. With respect to claims 7 and 10, although a recessed electrode and the specific inequality regarding the claimed sizing of the electrodes are not taught, it is clearly taught that the processing characteristics can be customized by tailoring the electrode configuration (paragraph 71 of JPO online translation). The courts have ruled that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

18. With respect to claim 8, said supply opening (Figures 3 and 5, 50) and said exhaust opening (Figures 3 and 5, 10) are formed to have a slit shape extending in one direction or formed as a plurality of holes arranged in one direction.

19. With respect to claim 9, said gas supplying means and said gas exhausting means are formed such that total flow rate of gas exhausted through said exhaust opening is not smaller than total flow rate of the processing gas supplied through said supply opening. See Figure 3 and paragraphs 63 and 64 of JPO online translation. Gas supplied, in is subsequently exhausted out, it does not accumulate. The specific flow rates are processing parameters that would be chosen based on the process being executed.

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20. With respect to claim 11, a grounded conductive cover (23 and 28) is provided to cover externally exposed surfaces of said first and second electrodes. They are provided for the purpose of serving as the body of the apparatus.

21. Claims 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yara et al. and Koinuma et al. and Kubota et al. as applied to claims 1-11 above, and further in view of Japanese Patent No. 2001103199 A to Nakamura et al.

22. Yara et al. and Koinuma et al. and Kubota et al. disclose the invention substantially as claimed and as described above.

23. However, Yara et al. and Koinuma et al. and Kubota et al. fail to teach a third electrode positioned next to said second electrode on a side opposite to said first electrode with respect to said second electrode, said apparatus being formed in symmetry with respect to said second electrode.

24. Nakamura et al. teach providing a third electrode in a dielectric discharge apparatus so that a lengthened plasma space is provided and a substrate can be processed while being conveyed through the space (Figure 11, paragraphs 65-69 of JPO online translation).

25. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to have provided a third electrode in Yara et al. and Koinuma et al. and Kubota et al. in order to provide a lengthened plasma space for a conveyed substrate as taught by Nakamura et al.

#### ***Response to Arguments***

26. Applicant's arguments filed 22 June 2006 have been fully considered but they are not persuasive.

27. With respect to Applicant's arguments regarding the filling of the volume between adjacent electrodes, Examiner notes that in the prior art the volume is at least partially filled and that the claims do not require for the volume to be completely filled so that plasma is not generated. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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28. With respect to the arguments of the rejection of claim 3, examiner notes in response to applicant's argument that the claimed invention teaches the provision of a dielectric on the surfaces of the electrodes for a reason different than the prior art, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

26. With respect to claim 5, as described above, in Yara et al., all of the electrodes are positioned on a single side of the substrate thus an electric line of force connecting said first and second electrodes when a voltage is applied between the electrodes extends above and substantially parallel to the surface of the object.

29. Examiner maintains that the recitations of claims 7 and 10 are based on optimization that would be obvious to one of ordinary skill in the art.

### **Conclusion**

30. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

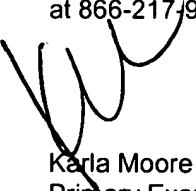
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karla Moore whose telephone number is 571.272.1440. The examiner can normally be reached on Monday-Friday, 9:00 am-6:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Parviz Hassanzadeh can be reached on 571.272.1435. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Karla Moore  
Primary Examiner  
Art Unit 1763  
18 September 2006